REMARKS

Applicants note the Examiner's modification of the restriction requirement made in the office action dated December 8, 2004. The elected Group I claims are now claims 1-6 and 8-10 (rather than claims 1-10) and the nonelected claims withdrawn from consideration are claims 7 and 11-14 (rather than claims 11-14).

Claim 2 has been amended to clarify that its limitations refer to a particular way of carrying out the first step of the process of claim 1.

Claims 5, 6 and 8 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which the applicant regards as the invention.

Applicants submit that this rejection has been obviated by the deletion of claims 5 and 6 and by the amendment to claim 8. The Examiner is respectfully requested to reconsider and withdraw the rejection.

All pending claims not withdrawn from consideration (claims 1-6 and 8-10) are rejected under 35 USC 103(a) over "the admitted prior art" as set forth at pages 1-2 of the instant specification in view of Wertheimer (Reference A) (U.S. Patent No. 1,376,366). This rejection is respectfully traversed.

This invention concerns a method of making contact lenses. The general process of making lenses of concern here has three discernible portions: (a) making lens mold tools, b) using the tools to make lens molds, and (c) using the molds to make contact lenses. See the last full paragraph on page 1 of the specification and the last full paragraph of the specification. Identifying indicia are commonly used on contact lenses for the purposes described in the first paragraph of the Background of the Invention on page 1 of the Specification. These indicia are formed by acid etching the indicia into the mold tools, forming a mold from the tool which mold receives a negative image of the indicia, and then molding a contact lens from tool, the lens having the desired indicia in its surface. See again the last paragraph of page one of the specification.

The foregoing paragraph states what Applicants understand to be "the admitted prior art" relied on by the Examiner.

The problem faced by Applicants was the cracking and splitting of contact lenses (the product of the third portion of the inventive method). The invention described in the specification and recited in the claims is the discovery that the cracking/splitting problem could be overcome by changing the method of etching indicia in mold tools in the first portion of the three-portion method of making contact lenses. The new etching method comprises electrochemically removing metal from a metal mold tool to form anisotropic indicia in the metal mold tool that correspond to indicia for the contact lens. See claims 1 and 9. The etching method is more particularly recited in claim 2. Also see claims 3-4, 8 and 10.

The Examiner contends that "the admitted prior art discloses the basic claimed process for forming a contact lens with indicia by etching a metal mold isotropically and molding the contact lens therefrom". Applicants agree that the process described in the quote is prior art but Applicants do not agree that the process described in the quote is "the basic claimed process". It clearly is not.

The Examiner contends:

> Wertheimer (see figure) discloses patterning a metal stencil plate or die (1) in the same manner as the instant mold is patterned to make the indicia – namely, etching in an acid bath with a chloride (2) with the marked die (col. 1, lines 79-80) as the anode. It is fairly well known in the art that such etching of a metal is in fact an anisotopic etch. It would have been obvious to one of ordinary skill in the art at the time of invention to have replaced the isotropic chemical etching in the admitted prior art as anisotropic electrochemical etching as generally taught by Wertheimer dependent on the exact etchants and metal used for the mold. Note that isotropic and anisotropic etching are each well known in the art (as is electrochemical etching) and that the selection of any particular etching over the other would have been within the skill level of the art based on parameters readily determined through routine experimentation, the suitability determined by etchant, material etched and shape and size of the etched area. One of ordinary skill would have readily determined the most suitable etching method.

Applicants agree that anisotopic etching is known. Where Applicants diverge from the Examiner's reasoning is where the Examiner contends that the selection among etching methods was determined through routine experimentation. The invention deals with the problem of splits and cracks in a contact lens. There is no evidence of an association between this problem and the selection of etching methods.

The Examiner is requested to reconsider and withdraw the rejection and to allow claims 1-4 and 8-10.

No additional fee is believed to be due. However, please charge any additional fees or credit overpayment to Deposit Account No. 02-1425.

Accordingly, it is believed that all claims are now in condition for allowance, early notice of which would be appreciated. The Examiner is invited to contact the undersigned to resolve any remaining issues.

Respectfully submitted,

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